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OFFICE OF PETITIONS

In re Application of
Bowles et al.
Application No. 09/901,210
Filed: July 9, 2001
For: METHOD FOR HIGH DEFINITION
DIP TRANSFER PRINTING AND
ARTICLE MADE ACCORDING TO
METHOD

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: DECISION DISMISSING
: PETITION
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This is in reply to "Urgent Petition to the Commissioner under 37 CFR 1.181 Requesting Retraction of Publication of Application" which was received via facsimile transmission on January 29, 2003. Petitioner argues that the above identified application was published in error, because a non-publication request was simultaneously and conspicuously filed with the application on filing. Petitioner argues that this is evidenced by the non-publication request on the transmittal letter.

The petition is **DISMISSED**.

35 U.S.C. 122(b) requires the United States Patent and Trademark Office to publish utility and plant applications filed on or after November 29, 2000, unless, on filing, applicant requested nonpublication with the required certification. The statute also permits the Office to publish applications filed before November 29, 2000, when applicant requests publication of such an application.

37 CFR 1.213(a)(2) requires that any nonpublication under 35 U.S.C. 122(b) request be published in a conspicuous manner.

The "nonpublication request" listed as an element of the application on the transmittal letter filed with the application is not is not conspicuous. The "nonpublication request" listed as one of the many application elements on the application transmittal letter is in a very small font size and is not in a larger size or of a different style to set it apart from the other elements listed on the application transmittal letter. Additionally, the application transmittal letter traditionally list elements which are included as separate papers or parts of the application and are not part of the transmittal letter themselves.

The Office has attempted to discouraged applicants from placing the Nonpublication Request in transmittal letters, as it may not be noticed. See Helpful Hints Regarding Publication of Patent Applications, 1249 Off. Gaz. Pat. Office Notices 83, (August 21, 2001), which states "[a] non-conspicuous request such as a request included on an application transmittal letter will generally not be noticed, and the application will be assigned a publication date. Applicants are encouraged to use USPTO Form PTO/SB/35, if a nonpublication request is to be made and applicants do not want the application published and the benefits of 35 U.S.C. § 154(d)."

Additionally, see the following Q & A from the website:

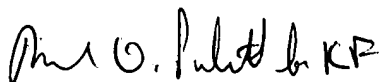
CQ4. I did not use the USPTO form, "Nonpublication Request Under 35 U.S.C. 122(b)(2)(B)(i)" (posted at <http://www.uspto.gov/web/forms/sb0035.pdf>), when I filed a patent application. Instead I put the request for non-publication in the body of the declaration for the patent application under 37 CFR 1.63. My application was assigned a publication date. How can I get the non-publication request treated and not have my application published? (Renumbered from CA4; Updated 10/01)

A request for non-publication will not be recognized unless it is conspicuous. See 37 CFR 1.213(a)(2). Providing text as one paragraph among numerous other paragraphs with no highlighting of the request for non-publication is not conspicuous, and thus the Office's assignment of a publication date was appropriate. To avoid publication you may expressly abandon the application, and file a new application under 37 CFR 1.53(b), claiming priority to the earlier-filed application, with a "Nonpublication Request under 35 U.S.C. 122(b)(2)(B)(i)" (posted at <http://www.uspto.gov/web/forms/sb0035.pdf>) or make the request and certification in a similarly conspicuous manner when filing the patent application. If your application has been assigned a publication date within the next one to six months, you should consider filing a petition for express abandonment under 37 CFR 1.138(c). If your application has been assigned a publication date within the next four weeks, then it is too late to avoid publication of the application. See Changes to Implement Eighteen-Month Publication of Patent Applications, Final Rule, 65 Fed. Reg. 57024, 57034, Sep. 20, 2000, 1239 Off. Gaz. Pat. Office 63, 73 (October 10, 2000). Applicant would have a similar remedy in other situations where the request is not conspicuous, for example, where the request is in the specification of the application, on a fee transmittal sheet, or buried in the transmittal letter.

The application is being returned to Group Art Unit 1734 to await further examination in due course.

The petition fee of \$130.00 under 37 CFR 1.17(h) will be charged to petitioner's Deposit Account No. 19-5029.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (703) 308-8122.



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